

REMARKS

Claims 1 through 29 are pending in this application, of which claims 12 through 28 stand withdrawn from consideration pursuant to the provisions of 37 CFR §1.142(b). Accordingly, claims 1 through 11 and 29 are active.

Claim 1 has been amended and new claim 29 added. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure, noting the depicted embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present amendment does not generate any new matter issue.

Clarification of the Record

In the initial Office Action summary, various inaccuracies appeared. These inaccuracies include a two-month period for response; whereas, claim 21 was substantively rejected under the second paragraph of 35 USC §112 and 35 USC §102, which rejection was not indicated in the Office Action summary. However, a three-month response date was indicated in the second paragraph on page 7. Moreover, in the Office Action Summary, the Examiner did not acknowledge the claim for foreign priority and receipt of the certified priority document, but did acknowledge the claim for foreign priority and receipt of the certified document on page 2 thereof. The Office Action indicates that claims 4 through 28 are withdrawn from consideration; whereas claims 7 through 28 are withdrawn from consideration. Rather than claims 1 through 3 and 4 through 11 subject to objection as indicated, the Examiner objected to claims 2 through 6. Moreover, the initialed copy of Form PTO-1449 provided by the Examiner is less than clear as to whether the "other art" was considered as a diagonal line does not appear as in the case of the U.S. patent

documents. After discussing these issues by telephone on April 18, 2003, the Examiner agreed to fax a corrected version of the Office Action summary. In this corrected version faxed on April 18, 2003, a three-month response date is specified. However, Examiner Le still did not acknowledge the claim for foreign priority.

Accordingly, Examiner Le is requested to acknowledge the claim for foreign priority pursuant to 35 USC §119 and receipt of the certified priority document. Examiner Le is also requested to clarify the record by providing an appropriately initialed copy of form PTO-1449 clearly indicating consideration of each of the cited references, including each of the references listed as "OTHER ART."

Claim 1 was rejected under the second paragraph of 35 USC §112

In the statement of the rejection, the Examiner merely stated that the process step "while forming a void on a recessed portion of mass layer" was not given patentable weight. This rejection is traversed.

Firstly, independent claim 1 is directed to a nitride-based semiconductor element -- not to a method. Secondly, the language the Examiner considered objectionable has been deleted from claim 1.

Thirdly, indefiniteness under the second paragraph of 35 U.S.C. §112 is a **question of law**, not form. *Personalized Media Communications LLC v. U.S. International Trade Commission*, 161 F.3d 696, 48 USPQ2d 1880 (Fed. Cir. 1998); *Tillotson, Ltd v. Walboro Corp.*, 831 F.2d 1033, 1 USPQ2d 1450 (Fed. Cir. 1987); *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). Accordingly, in rejecting a claim under the second paragraph of 35 U.S.C. §112, the Examiner must provide a basis in fact and/or cogent technical reasoning to support

the ultimate legal conclusion that one having ordinary skill in the art, with the supporting specification in hand, would not be able to reasonably ascertain the scope of protection defined by a claim. *In re Okuzawa*, 537 F.2d 545, 190 USPQ 464 (CCPA 1976). Significantly, consistent judicial precedents holds that reasonable precision in light of the particular subject matter involved is all that is required by the second paragraph of 35 U.S.C. §112. *Zoltek Corp. v. United States*, *supra*; *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993); *North American Vaccine, Inc., v. American Cyanamid Co.*, 7 F.3d 1571, 28 USPA2d 1333 (Fed. Cir. 1993); *U.S. v. Telectronics Inc.*, *supra*; *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ (Fed. Cir. 1986). Applicants stress that claims must be interpreted as one having ordinary skill in the art would have interpreted the claims in light of and consistent with the supporting specification. *Zoltek Corp. v. United States*, *supra*; *Miles Laboratories, Inc. v. Shandon, Inc.*, *supra*.

In applying the above legal tenets to the exigencies of the case, Applicants submit that the Examiner did not discharge the initial burden of establishing a *prima facie* basis to deny patentability to the claimed invention under the second paragraph of 35 U.S.C. §112. Specifically, the Examiner has offered absolutely no reason **why** claim 1 is indefinite under the second paragraph of 35 USC §112. It is not apparent and the Examiner does not explain why one having ordinary skill in the art would have any difficulty understanding the scope of the claimed invention, particularly when reasonably interpreted in light of and consistent with the written description of the specification which is the judicial standard. *Miles Laboratories v. Shannon*, *supra*. In fact, the Examiner has not articulated any reason whatsoever, thereby denying Applicants' procedural due process of law. See, for example, *In re Frilette*, 423 F.2d 1397, 165 USPQ 259 (CCPA 1970); *In re Borkowski*, 422 F.2d 904, 164 USPQ 642 (CCPA 1970).

Applicants, therefore, submit that the imposed rejection of claim 1 under the second paragraph of 35 USC §112 is not legally viable and, hence, solicit withdrawal thereof.

Claim 1 was rejected under 35 USC §102 for lack of novelty or, alternatively, under 35 USC §103 for obviousness predicated upon Sugiura et al.

In the statement of the rejection, the Examiner referred to Fig. 7 or Fig. 12 of Sugiura et al., asserting the disclosure of a nitride-based semiconductor element corresponding to that claimed. The Examiner admitted the recitation "while forming a void on recess portion of mask layer" was not disclosed by Sugiura et al. Nevertheless, the Examiner declined to accord such limitation any patentable weight asserting it is a process limitation. This rejection is traversed as factually erroneous.

The factual determination of lack of novelty under 35 USC §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Elan Pharmaceuticals, Inc. v. Mayo Foundation*, 64 USPQ2d 1292; *Crown Operations, International Ltd. v. Solutions, Inc.*, 62 USPQ2d 1917. There is a significant difference between the claimed semiconductor element and that disclosed by Sugiura et al. that scotches the factual determination that Sugiura et al. disclose a semiconductor element identically corresponding to that claimed.

Firstly, it is legal error to ignore any claim limitation. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Secondly, the claim limitation for a void is not a method limitation but a structural limitation. A void, manifestly, is part of a structure.¹ At any rate, claim 1 has been amended by clarifying that the claimed nitride-base semiconductor element comprises "a void on said recess portion of said mask layer." The Examiner admits that Sugiura et al. do not disclose such a void on a recess portion of the mask layer. Ergo, the claimed device is **structurally different** from the device disclosed by Sugiura et al., thereby undermining the factual determination that Sugiura et al. disclose a device identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Furthermore, there is no apparent factual basis upon which to predicate the conclusion that one having ordinary skill in the art would have been realistically impelled to deviate from the teachings of Sugiura et al. and purposely form a void in the mask layer. *In re Lee*, 61 USPQ2d 1430.

Applicants, therefore, submit that the imposed rejection of claim 1 under 35 USC §102 for lack of novelty or, alternatively, under 35 USC §103 for obviousness predicated upon Sugiura et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

New claim 29

New claim 29 is free of the applied prior art by virtue of its dependence upon independent claim 1, the patentability of which has been argued supra.

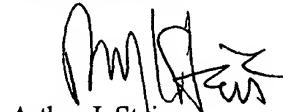
¹ Even process limitations and device claims cannot be ignored when they impact the structure. *In re Garnero*, 412 F.2d 276, 162 USPQ 221 (CCPA 1969).

It should, therefore, be apparent that the imposed rejections have been overcome and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Arthur J. Steiner
Registration No. 26,106

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 AJS:caca:mcm
Facsimile: (202) 756-8087
Date: August 6, 2003